

In Claim 14, line 2, change "adapter plate" to --anchoring--.

#### **REMARKS**

This Application has been reconsidered in light of the Office Action dated March 3, 1997, and the references cited therein. Applicant hereby requests further examination and reconsideration of the Application in view of the foregoing amendments.

It is noted with appreciation that Applicant's Claim 1 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112 as set forth in the Office Action.

Further, it is noted that Applicant's Claims 2-14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 as set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims.

Accordingly, Applicant has amended Claims 1-14 to overcome the rejections under 35 U.S.C. § 112 as so kindly suggested by Examiner to place the Application in condition for allowance.

#### **OATH/DECLARATION DEFECTIVE**

The Oath or Declaration is defective. A new Oath or Declaration in compliance with 37 CFR 1.67(a) identifying this Application by application number and filing date is required.

The appropriate paragraph of the Office Action setting forth the basis for this requirement is as follows:

The Oath or Declaration is defective because:

It states that the two inventors are sole inventors, not joint inventors of the invention claimed.

Accordingly, Applicant is submitting herewith a new Oath or Declaration stating that the inventors are joint inventors of the invention claimed in compliance with 37 CFR 1.67(a).

### **DRAWING OBJECTIONS**

The drawings are objected to because the drawings do not include certain reference signs mentioned in the description. 37 CFR § 1.84(f) states, "reference signs not mentioned in the description shall not appear in the drawing and vice versa."

The appropriate paragraph of the Office Action setting forth the basis for this objection is as follows:

The following reference signs are not included in the drawings: "16' " as discussed on page 18 line 1; "20' " on top of pole 40' as discussed on page 18 first paragraph. Correction is required.

Accordingly, Applicant has amended the specification to conform the reference signs mentioned therein to be drawings. Further, Applicant is submitting herewith proposed drawing corrections to conform the drawings to the specification.

### **SPECIFICATION - OBJECTIONS**

The Specification is objected to because of various informalities as set forth in the Office Action. The appropriate paragraphs of the Office Action setting forth the basis for these objections is as follows:

3. The titles should be changed so as to be clearly indicative of the invention to which the claims are directed, i.e., "and Method of Using the Same" should be deleted.

4. The disclosure is objected to because of the following informalities: page 3, line 14, change "No. 20,653 to --No. RE 20,653--. Appropriate correction is required.

5. The Abstract of the Disclosure is objected to because "This invention is an" should be changed to --An--. Correction is required. See M.P.E.P. § 608.01(b).

Accordingly, Applicant has amended the specification to comply with the objections as so kindly pointed out by the Examiner.

### **CLAIM REJECTIONS - 35 U.S.C. § 112**

Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The appropriate paragraphs of the Office Action setting forth the basis for this rejection is as follows:

As concerns Claim 1, "the bottom end" lacks antecedent basis, both for referring to "bottom" without a frame of reference and for referring to "the end" when no ends of the stanchion have been defined. Also, this claim as presented is indefinite in that it is not clear as to whether the temporary guard rail system is being claimed *in combination* with the building structure; Claim 1 states "and being adapted to be removably mounted to a building structure" which implies that the intention is not to claim the building structure. However, further, Claim 1 recites "said toe board being positioned adjacent the floor of said building structure", thus claiming the building structure. Clarification of the intention of this claim is necessary.

As concerns Claim 2, "an upper horizontal side rail" should be changed to --an upper side rail-- to avoid improper antecedence.

As concerns Claim 3, the use of "may be" and "by use of" is indefinite in that it is unclear whether the "adapter means" is being claimed or not. Also, the term(s) adaptor is used to modify the word "means", thus purporting to conform to 35 USC 112, sixth paragraph. However, 35 USC 112, sixth paragraph, requires that the term(s) specify a function to be performed, thus enabling a determination of the structural equivalent thereof. For example, expressions such as "latch means" or "means for latching" have functional connotations and are in conformity with the statute. However, in this case, the term(s) have no functional connotations. See Ex parte Klumb, 159 USPQ 694. Correction is required.

As concerns Claim 4, "adapter means" and "swivel plate means" do not conform to 35 USC 112, sixth paragraph. Also, "said first threaded stud", "said top end", said top stanchion" and "said swivel plate" (line 7) lack antecedent basis.

As concerns Claim 5, "swivel plate means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 6, "adapter means" (two occurrences) does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 7, "adapter means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 11, "ground adapter plate means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 12, "ground (adapter) plate means" (two occurrences) does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 13, "roof adapter plate means" does not conform to 35 USC 112, sixth paragraph.

As concerns Claim 14, "roof adapter plate means" does not conform to 35 USC 112, sixth paragraph.

Accordingly, Applicant has amended Claims 1-14 to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

More particularly, Applicant has amended Claims 1-14 to comply with each and every rejection set forth in the Office Action in order to comply with 35 U.S.C. § 112, second paragraph and sixth paragraph.

Accordingly, Applicant respectfully submits that the Claims 1-14 are now in condition for allowance.

#### **DOUBLE PATENTING**

Claims 1-3, 6, 9 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the Claims 1-8, 10-13 and 17 of copending Application No. 08/755,596 in view of Lamb 2,136,696 and Bourne et al.

The appropriate paragraph of the Office Action setting forth the basis for this rejection is as follows:

Application No. 08/755,596 discloses the claimed invention, but lacks a toe board and a means for extending the vertical height of the guard rail system. Lamb teaches the use of a telescopically adjustable toe board. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a telescopically adjustable toe board in view of Lamb '696 in order to provide a means to protect objects from rolling off a staircase

or balcony where the guard rail system is installed and to allow adjustability of the toe board in the same manner as the side rails, i.e., telescoping capability. Bourn et al. teaches the use of a means for extending the vertical height of a guardrail system. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a means for extending the vertical height thereof in view of Bourn et al. in order to provide a more versatile guard rail system which can be adjusted vertically based on the site circumstances, height of workers, etc.

Claims 11-14 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-8, 10-13 and 17 of copending Application No. 08/755,596 in view of Lamb 2,136,696, Bourn et al. and Stewart.

The appropriate paragraph of the Office Actions setting forth the basis for this rejection is as follows:

Application No. 08/755,596, Lamb '696 and Bourn et al. show the claimed invention, but lack a ground adapter plate means. Stewart, Jr. shows a ground adapter plate means (that portion of plate 12 which connects with 13; the other portion of 12 being considered as the anchor bracket). It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the guard rail system to have a ground adapter plate means in view of Stewart, Jr. in order to provide a more stable connection to the ground surface.

This is a provisional obviousness-type double patenting rejection.

Accordingly, Applicant is submitting herewith a terminal disclaimer in accordance with § 1.321(b) to dedicate to the public any terminal part of the patent term which may be granted in the present Application to obviate the provisional obviousness-type double patenting rejection.

Claims 1-3, 6, 9-14 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 08/755,596 which has a common inventor with the instant Application.

The appropriate paragraphs of the Office Action setting forth the basis for this rejection are as follows:

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 103(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. Application No. 08/755,596 shows the claimed invention except for the telescoping toe board, the vertical height adjustment and the adapter plate means. These items have been shown to be known in the art as discussed above.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

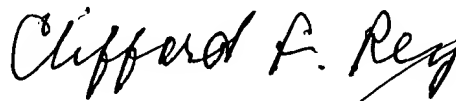
The telephone interview granted by the Examiner on May 14, 1997, to resolve the above rejection of Claims 1-3, 6, and 9-14 is greatly appreciated.

It has been verified by the Examiner that both the parent Application (Serial No. 08/755,596) and the instant Application in this case have been assigned to the same person thereby obviating the provisional rejection of Claims 1-3, 6, and 9-14 under 103(a).

For all of the reasons given above, Applicant respectfully submits that the Application is now in full condition for allowance. Reconsideration and withdrawal of the rejections is requested.

Should the Examiner feel that it would expedite prosecution to discuss the Application with counsel, please give me a call.

Respectfully submitted,



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CERTIFICATE OF MAILING

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Date 6-2-97

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APPR  
A.C.  
8/20/61

Proposed  
drawing change

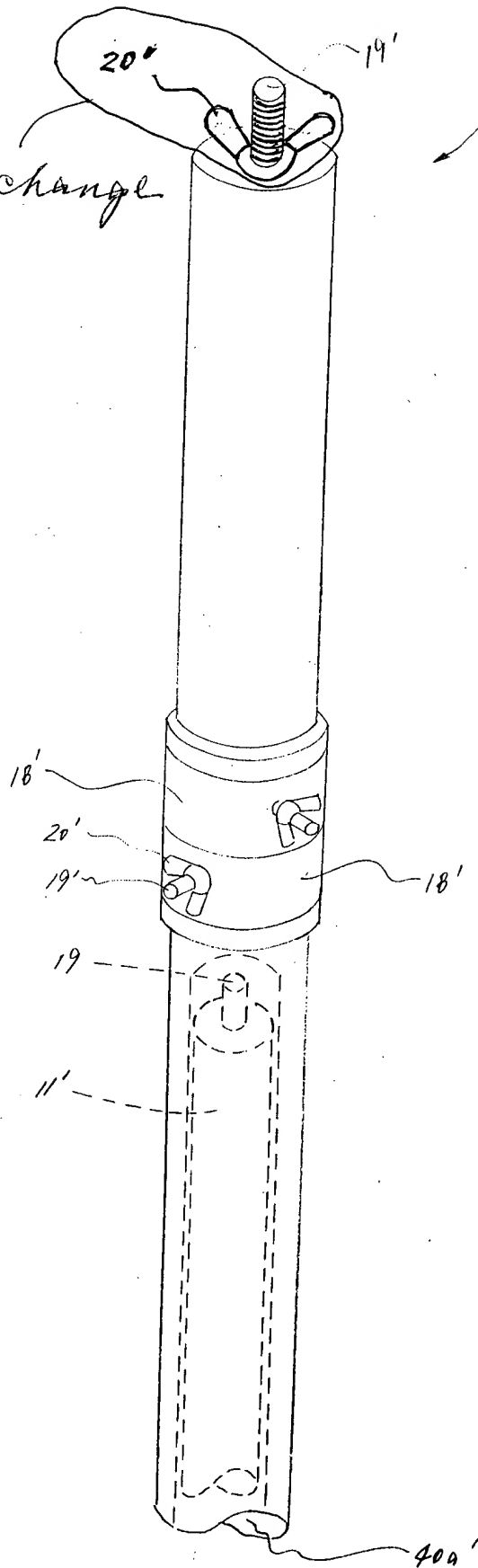


FIG. 16

APPROVED  
A.C.  
8/20/97

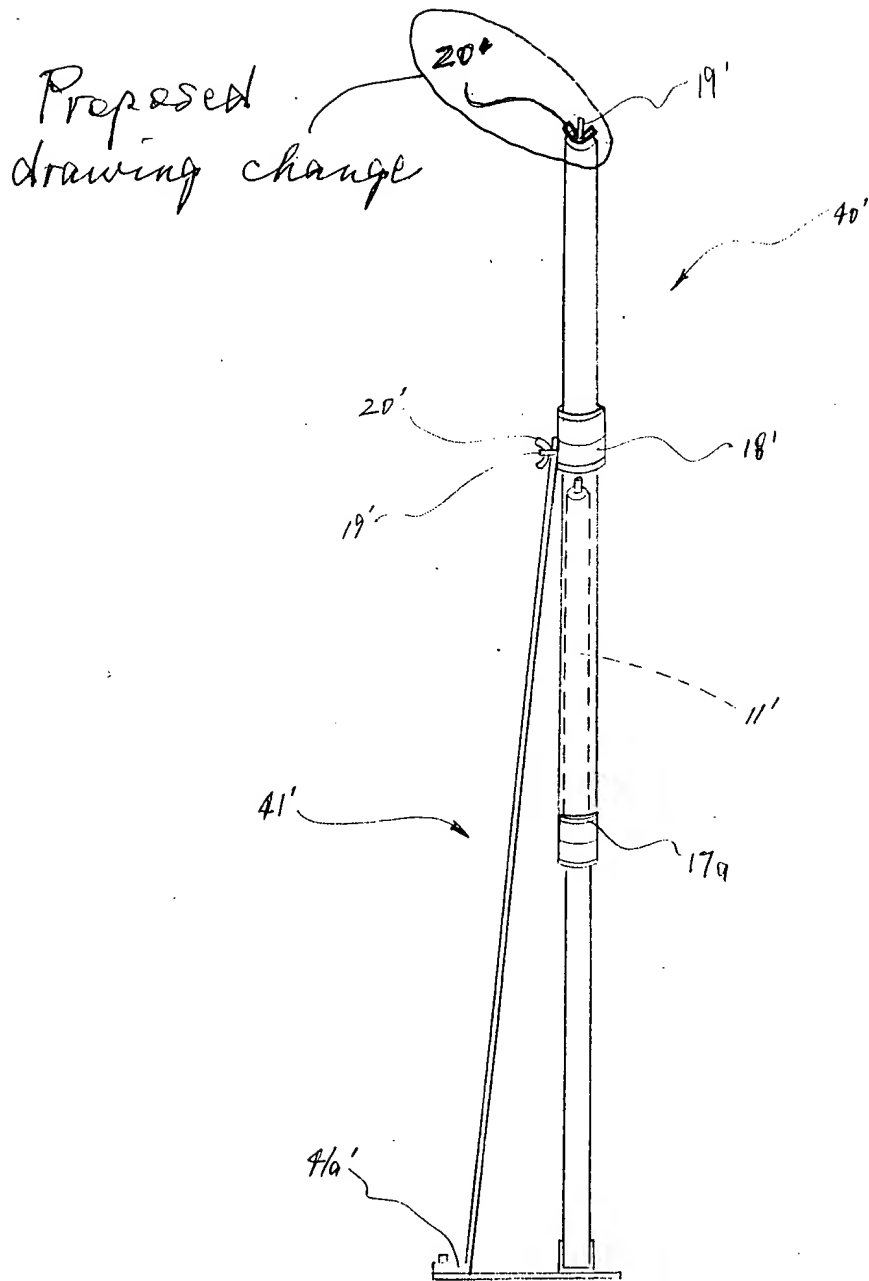


FIG. 17